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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,312	10/08/2003	Anthony G. Macaluso	13817-005001	7323
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FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER VU, MICHAEL T	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/682,312	<b>Applicant(s)</b> MACALUSO, ANTHONY G.	
	<b>Examiner</b> Michael Vu	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-29, 32-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-29, 32-37, 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's arguments with respect to claims 1-4, 6-29, 32-37, 39-41 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deshpande (US 2003/0003933) in view of Minear (US 2003/0032417), and further in view of McCormack (US 2003/0074660).

Regarding **claims 1, 16**, Deshpande teaches a method for providing services to a mobile device (Figure #1), the method comprising: receiving a request from the mobile device for choices of available service providers [0007-0008] and associated mobile service subscription choices [0007-0008]; sending data to the mobile device relating to identification of the available service providers [0014-0015] and the associated mobile service subscription choices

[0014-0019], wherein the choices of available service providers [0014-0019] and the associated subscription choices are sent to the mobile device over a wireless communication path [0008-0019], the choices of service providers and subscription choices are for selection by a user of the mobile device [0008-0019], and receiving a selection of at least one of the available service providers [0008-00019] and at least one of the associated subscription choices from the mobile device over the wireless communication path [0014-0019]; and activating a service corresponding to the at least one selected service provider and at least one associated subscription choice in response to the selection.

**But Deshpande is unclear on** the subscription choices comprise choices to initiated or modify a subscription associated with at least one of the available service providers to enable wireless communications over a wireless network.

However, Minear teaches a method and system, in which the user may later request that addition programs, applications, and/or the wireless device can customize their wireless phone through the selective downloading of applications choices over cellular telecommunication carrier networks, and further teaches the users of wireless telephone desired to download applications to the wireless device by using the BREW platform (Figs. 1-5, [0005-0006, 0010-0014]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Deshpande, such that the subscription choices are for selection by a user of the mobile device, and the subscription choices comprises choices to initiate or modify a subscription to enable wireless communications over a wireless network, to provide the flexibility of users

desired to select, option, customize, choose, and/or control the deleting, reloading, and modifying of select the applications download from server to the wireless devices via the wireless network.

**But Deshpande/Minear do not teach on** that include at least a choice of mobile calling plan is selected by a user.

However, McCormack teaches to the field of portable electronic devices and networked electronic communication includes a wireless cellular phone system provides different subscribers with different calling plans specifically selected by the subscriber [0005].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Deshpande/Minear, such that include at least a choice of mobile calling plan is selected by a user, to provide the flexibility of users desired to select a calling plan in different environments such downloading from the server to the wireless devices via the wireless network.

Regarding **claim 2**, Deshpande/Minear teach the method of claim 1, wherein the request for mobile subscription choices from the mobile device comprises an activation request [0019] of Deshpande.

Regarding **claim 3**, Deshpande/Minear teach the method of claim 1, wherein the mobile device comprises a mobile phone (Fig. 1, mobile phone) of Minear.

Regarding **claims 4, 23**, Deshpande/Minear teach the method of claim 1, wherein the mobile device is capable of operation with a plurality of service providers ([0025], Providers=Carriers/Servers) of Minear.

Regarding **claims 6, 20**, Deshpande/Minear teach the method of claim 1, wherein the available service providers comprise mobile virtual network operators [0025] of Minear.

Regarding **claim 7**, Deshpande/Minear teach the method of claim 1, wherein activating a service comprises sending data representing at least one setting for the mobile device, with the data being sent over the wireless communication path [0008-0019] of Deshpande.

Regarding **claims 8, 17**, Deshpande/Minear teach the method of claim 7, wherein the at least one setting allows the mobile device to obtain service from the selected service provider [0008-0019] of Deshpande.

Regarding **claims 9, 18**, Deshpande/Minear teach the method of claim 7, wherein the at least one setting comprises a preferred roaming list [0008-0019] of Deshpande.

Regarding **claims 10, 21-22**, Deshpande/Minear teach the method of claim 7, wherein the data relating to mobile subscription choices and the data representing at least one setting for the mobile device are adapted for use on a Binary Runtime Environment for Wireless (BREW) platform on the mobile device [0030] of Minear.

Regarding **claims 11, 19**, Deshpande/Minear teach the method of claim 7, wherein the data relating to mobile subscription choices and the data representing at least one setting for the mobile device are adapted for use on a Java platform on the mobile device [0030] of Minear.

Regarding **claim 12**, Deshpande/Minear teach z the method of claim 7, wherein the data relating to mobile subscription choices comprises an identification of a plurality of available service plans [0019] of Deshpande.

Regarding **claim 13**, Deshpande/Minear teach the method of claim 1, wherein activating a service comprises selecting settings data associated with the selected subscription option from stored respective sets of settings data associated with each of the mobile services subscriptions choices [0008-0019] of Deshpande.

Regarding **claim 14**, Deshpande/Minear teach the method of claim 13, wherein the settings data comprises a preferred roaming list selected from a plurality of preferred roaming lists [0019] of Deshpande.

Regarding **claim 15** Deshpande/Minear teach the method of claim 1, wherein the method is performed by a server remote from and in wireless communication with the mobile device (Figure #2) of Minear.

4. Claims 24-29, 32-37, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minear (US 2003/0032417) in view of Deshpande (US 2003/003933), and further in view of McCormack (US 2003/0074660).

Regarding **claim 24**, Minear teaches a mobile device (Figure #2, Mobile Device #12) comprising: a transceiver (Figure #2, Mobile Device #12) operable to communicate over a wireless communication link (Figure #2, Mobile #12 to Base station #44); at least one memory (Figure #2, Memory # 56) storing an address

of a server that stores settings data associated with at least one mobile service and storing client software for an application execution environment (Stored in a Local Database # 58), wherein the at least one mobile service ( Service Provider #40) comprises a service to enable wireless communications over a wireless network (Figure #2), and the at least one memory is operable to store at least one application that is executable on the client software [0014] and that includes instructions for communicating with the server at the stored address [0032, 0037], receiving settings data (Figure #2, Receive Unit # 50), and storing the received settings data in the at least one memory (Figure #2, #56); a processor coupled to the transceiver and the at least one memory (Figure #2, #56), wherein the processor is operable to execute the at least one stored application (ASIC - Application-Specific Integrated Circuit #52, [0026]) and to control communications by the transceiver [0026];

**But Minear does not clearly disclose on** a visual display, wherein the at least one application comprises instructions for causing the processor to: retrieve a list of available service providers from the server, display the list of available service providers on the visual display, receive a user selection of a particular service provider, and transmit an indication of the user selection form the transceiver to the server.

However, Deshpande teaches a wireless device includes transceiver, controller, signal processing, memory and a display, in which the mobile device can assemble the information gathered about each available provider and then



present all or some of this information to the user (e.g., **through a display**) and allow the user to make the ultimate selection [0011-0012, 0018-0019].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Minear, such that a visual display, wherein the at least one application comprises instructions for causing the processor to: retrieve a list of available service providers from the server, display the list of available service providers on the visual display, receive a user selection of a particular service provider, and transmit an indication of the user selection from the transceiver to the server, to provide the flexibility of users desired to select, option, customize, or choose the applications download from server to the wireless devices via the wireless network.

**But Minear/Deshpande do not teach on** that include at least a choice of mobile calling plan is selected by a user.

However, McCormack teaches to the field of portable electronic devices and networked electronic communication includes a wireless cellular phone system provides different subscribers with different calling plans specifically selected by the subscriber [0005].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Minear/Deshpande, such that include at least a choice of mobile calling plan is selected by a user, to provide the flexibility of users desired to select a calling plan in different environments such downloading from the server to the wireless devices via the wireless network.

Regarding **claim 25**, Minear/Deshpande teach the method of claim 24, wherein the server comprises an application download server (Fig. 2, #16 Download Server) of Minear.

Regarding **claim 26**, Minear/Deshpande teach the mobile device of claim 24, wherein the client software comprises Binary Runtime Environment for Wireless (BREW) client software [0030] of Minear.

Regarding **claim 27**, the combination of Minear/Deshpande teach the mobile device of claim 26, herein the at least one application is adapted for execution by the BREW client software [0030] of Minear.

Regarding **claim 28**, Minear/Deshpande teach the mobile device of claim 26, wherein the client software comprises Java virtual machine software [0030] of Minear.

Regarding **claim 29**, Minear/Deshpande teach the mobile device of claim 24, wherein the received settings data comprises settings that enable wireless communications using a particular service provider [0018-0019] of Deshpande.

Regarding **claim 32**, Minear teaches a system comprising: an application download server (Figure #2, Server #16) storing mobile device settings for accessing services associated with at least one mobile service provider (Figure #2, Mobile Device #12, [0025-0027]), wherein the application download server is operable to selectively send the mobile device settings to selected mobile devices for use in modifying the settings for each selected mobile device [0024-0031]; and the services comprise a service to enable wireless communications over wireless network [0025-0027]; a mobile communication system interface for

connecting the application download server to a mobile communication system [0024-0031], wherein the mobile device settings are sent to the selected mobile devices over a wireless communication link between the selected mobile devices [0024-0031] and the mobile communication system (Figure #2, [0024-0031]); and wherein the application download server is further configured to store applications for downloading to the selected mobile devices through the mobile communication system, [0024-0031].

**But Minear does not clearly teach on** with at least one of the applications including instructions for enabling a user to select a particular service provider from available service providers to initiate or modify wireless communication services.

However, Deshpande teaches the communication system and a communication device for selecting a multiple service providers and identifying another provider with a better deal than the selected provider [0008-0015, 0019].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Minear, such that with at least one of the applications including instructions for enabling a user to select a particular service provider from available service providers to initiate or modify wireless communication services, to provide the flexibility of users desired to select, option, customize, choose, and/or control the deleting, reloading, and modifying of select the applications download from server to the wireless devices via the wireless network.

**But Minear/Deshpande do not teach on** that include at least a choice of mobile calling plan is selected by a user.

However, McCormack teaches to the field of portable electronic devices and networked electronic communication includes a wireless cellular phone system provides different subscribers with different calling plans specifically selected by the subscriber [0005].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Minear/Deshpande, such that include at least a choice of mobile calling plan is selected by a user, to provide the flexibility of users desired to select a calling plan in different environments such downloading from the server to the wireless devices via the wireless network.

Regarding **claim 33**, Minear/Deshpande teach the system of claim 32, wherein the services associated with the at least one mobile service provider comprise wireless communication services [0015-0019] of Deshpande.

Regarding **claim 34**, Minear/Deshpande teach the system of claim 33, wherein the mobile device settings comprise settings necessary to enable the mobile devices to access the wireless communication services for the at least one mobile service provider [0015-0019] of Deshpande.

Regarding **claim 35**, Minear/Deshpande teach the system of claim 33, wherein the mobile device settings comprise a plurality of preferred roaming lists, with each preferred roaming list associated with a particular service provider [0015-0019] of Deshpande.

Regarding **claim 36**, Minear/Deshpande teach the system of claim 35, wherein a preferred roaming list is sent to each mobile device, with the preferred roaming list corresponding to a selection of a service provider received through the mobile communication system interface from the mobile device [0015-0019] of Deshpande.

Regarding **claim 37**, Minear/Deshpande teach the system of claim 33, wherein the at least one mobile service provider comprises a mobile virtual network operator [0015-0019] of Deshpande.

Regarding **claim 39**, Minear/Deshpande teaches the system of claim 38, wherein the applications are adapted for execution on a Binary Runtime Environment for Wireless (BREW) platform [0030] of Minear.

Regarding **claim 40**, Minear/Deshpande teach the system of claim 32, wherein the mobile device settings comprise a software patch for one or more selected mobile devices [0015-0019] of Deshpande.

Regarding **claim 41**, Minear/Deshpande teach the system of claim 32, wherein the mobile device settings comprise a telephone number [0015-0019] of Deshpande.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Vu whose telephone number is (571) 272-8131. The examiner can normally be reached on 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael Vu  
Examiner

JEAN GELIN  
PRIMARY EXAMINER

